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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,601	11/28/2003	Masahiro Motomiya	246009US90	8267
22850	7590	04/07/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SHAFFER, RICKY D	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/722,601	Applicant(s) MOTOMIYA ET AL.	
	Examiner Ricky D. Shafer	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/12/03 & 1/18/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of invention II (claims 3, 5(3), 6(5,3), 7(5,3), 8(5,3), 9(6,5,3), 12(8,5,3) and 13(9,6,5,3) in the reply filed on 01/25/2006 is acknowledged. The traversal would appear to be on the ground(s) that there would be no undue burden to examine all of the non-elected inventions along with the elected invention. This is not found persuasive because the restriction requirement set forth in the communication mailed on 12/29/2005 is based on the claimed structural differences between the various inventions and not on their similarities. Continued search and examination of claims to a non-elected invention having substantially different structural limitations is a prima facie showing of burden. Applicant may overcome the requirement for restriction by presenting an allowable linking claim or by providing a clear admission on the record that the claim(s) drawn to a given non-elected species is not patentably distinct from the elected species.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 5(1), 6(5,1), 7(5,1) 8(5,1) 9(6,5,1), 12(8,5,1), 13(9,6,5,1), 5(2), 6(5,2), 7(5,2), 8(5,2), 9(6,5,2) 12(8,5,2) and 13(9,6,5,2) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Applicant timely traversed the restriction (election) requirement in the reply filed on 01/25/2006.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 5-9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, line 5, the use of the language "upward/downward" is vague and definite. The above language must be recited in the alternative only.

In claim 1, line 7, claim 2, line 5 and claim 5, line 3, the use of language "rightward/leftward" is vague and definite. The above language must be recited in the alternative only.

In claim 2, line 5, the language "a mirror angle...direction" lacks proper nexus with respect to "an angle...direction", recited in claim 1, lines 6-7.

In claim 3, line 2, the use of the language "retraction/return" is vague and definite. The above language must be recited in the alternative only.

In claim 3, lines 2-3, the language "a retraction and...housing" lacks proper nexus respect to "the mirror housing retracts...operating position", recited in claim 2, lines 3-4.

In claim 5, lines 2-3, the use of the language "detection/storage means for detecting and storing" is vague and indefinite. It is unclear to the how detection means can store and how storage means can detect.

In claim 5, lines 4-5, the language "the retracing (retracting) position" and "the operating position" each lacks proper antecedent basis.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Foote ('700).

Foote discloses an electrically retractable outer mirror for a vehicle comprising a mirror

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housing (12) having a mirror accommodated in the mirror housing, an angle of the mirror being adjustable relative to a vehicle body (see page 4, lines 21-24); wherein the angle of the mirror in an upward/downward direction is adjusted through an actuator (28) arranged in the mirror housing, and an angle of the mirror in a rightward/leftward direction is adjusted by a rotating movement of the mirror housing around an axis substantially extending along a vertical direction by element (20). Note figures 1, 2 and 13 along with the associated description thereof.

7. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Duroux et al ('128).

To the extent the claims are definite, Duroux et al discloses an electrically retractable outer mirror for a vehicle comprising a mirror housing (16) having a mirror (18) accommodated in the mirror housing, an angle of the mirror being adjustable relative to a vehicle body (see page 2, lines 9-28 and page 2, line 58 to line 5); wherein the angle of the mirror in an upward/downward direction is adjusted through an actuator (42) arranged in the mirror housing, and an angle of the mirror in a rightward/leftward direction is adjusted by a rotating movement of the mirror housing around an axis substantially extending along a vertical direction by element 36 (see page 2, lines 40-44 and page 3, lines 5 to 13), wherein the electrically retractable outer mirror further includes a housing rotating speed variable means (34,36,70,76,78,80,82,86,72,74) for varying a rotating speed of the mirror housing between an instance where the mirror housing retracts to a retracting position or returns to an operating position (see page 3, lines 5-13) and an instance where the mirror housing rotates the mirror angle adjustment in the rightward/leftward direction (see page 3, lines 14-20), a retraction/return switch (80,82) for operating a retraction and a return of the mirror housing, and a mirror angle adjustment switch (76,78) for adjusting the

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angle of the mirror, wherein element (70) of the housing rotating speed variable means inherently comprises a switch input determination circuit for determining whether a signal from the retraction/return switch and/or a signal from the mirror angle adjustment switch is actuated, at least either one of a motor apply voltage adjustment circuit or a motor apply current adjustment circuit in order to supply appropriate signals to motors (34,36) and a housing angle detection/storage means (86 and page 4, lines 27-29) which is capable of detecting and storing desirable positions of said mirror and said mirror housing, and at least one detecting member (72,74) for detecting a number of rotations of said mirror and mirror housing. Note figures 1 and 2 along with the associated description thereof.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duroux et al ('128) in view of Nakayama et al ('603).

To the extent the claims are definite, Duroux et al discloses all of the subject matter claimed, note the above explanation, except for explicitly stating that the mirror housing is positioned in a retracted position when doors of the vehicle are unlocked.

Nakayama et al teaches it is well known to use door lock controllers in conjunction with a rearview mirror controller in the same field of endeavor for the purpose of regulating the position of a mirror housing.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the controller of Duroux et al et al to include a typical door lock controller, as taught by Nakayama et al, in order to adjust the position of the mirror housing.

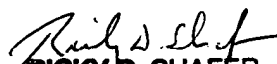
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS

April 02, 2006


RICKY D. SHAFER
PATENT EXAMINER
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